

Application No.: 10/518325  
Docket No.: BA9307USPCT

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## I.

In the Office Action claims 10-13 were rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps (MPEP 2172.01 was cited). The Office Action indicated that the omitted steps are the intermediary reactants and reaction steps leading up to the desired compound of Formula III after starting out with the compound of Formula Ia.

Claim 10 has now been amended to address a method for the preparation of a compound of Formula III (as defined therein) wherein a compound of Formula Ia (as defined therein) is used as an intermediate during said preparation. Applicant submits that although descriptions of using a Formula Ia compound during the production of a Formula III compound are provided in this application, this claim is not limiting to those descriptions. A claim is not defective when it states fewer than all of the steps that may be performed in practice of the invention. See, e.g., Smith & Nephew Inc. v. Ethicon 61 USPQ2d 1065, 1069 (Fed. Cir. 2002). Applicant submits that the focus of Claim 10 in terms of patentability should be on the preparation of the Formula Ia compound. Accordingly, Applicant submits that the subject matter of Claim 6 referenced in the characterizing portion of Claim 10 is sufficient for patentability; and that the application provides sufficient description and enablement for a method for the preparation of a compound of Formula III wherein a compound of Formula Ia is used as an intermediate during said preparation to make clear how the characterizing portion of Claim 10 relates to such a method as described in the earlier portion of the claim. In other words, the characterizing portion of Claim 10 contains essential material, and the earlier portion of the claim serves to indicate that the characterizing portion applies to a method for the preparation of a compound of Formula III wherein a compound of Formula Ia is used as an intermediate during said preparation (rather than to a method for the preparation of a compound of Formula III wherein a compound of Formula Ia is NOT used as an intermediate during said preparation).

Claim 14 has now also been added to more specifically recite by way of examples, use of a compound of Formula Ia. Applicant submits such use as recited in Claim 14 should not be taken as necessary in that it is conceivable that other ways of using Formula Ia compounds as intermediates during the preparation of Formula III compounds could be practiced. Claims 15 through 17 have also been added, and these three claims follow original claims 11 through 13, except that they depend directly or indirectly from new Claim 14, and Claim 15 indicates that the R<sup>4</sup> addressed therein is applicable to the Formula Ia compound (item (1) involves providing a compound of Formula 6 wherein R<sup>4</sup> is H). Applicant notes that various aspects of items (1), (2) and (3) now included in Claim 14 are presented in U.S. Patent Application

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Publication 2004/0198987 (see e.g., Schemes 3 through 6) and/or PCT Publication No. WO 04/011447 (see e.g., Scheme 1, the Scheme on page 22, Scheme 18 and Scheme 29).

## II.

The Office Action suggested that the subject matter of claims 1-9 was unobvious and that those claims were allowed.

## III.

In reviewing the file, it has been noted that the box checked for the translation on sheet 2 of 2 Non-Patent Literature Documents accompanying the Information Disclosure Statement for this case did not correctly align with the document (Jose Elguero et al.) to which the submitted translation pertained. Accordingly, a corrected sheet 2 is attached hereto, and the Examiner is respectfully requested to re-initial this form, with the corrected translation acknowledgement.

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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